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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/384,646	08/27/1999	KEVIN BIRNIE	1-1-1-1	8093

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EXAMINER
PEREZ GUTIERREZ, RAFAEL

ART UNIT	PAPER NUMBER
2683	12

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

Office Action Summary

Application No.	Applicant(s)
09/384,646	Birnie et al.
Examiner	**Art Unit**
Rafael Perez-Gutierrez	2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) [X] Responsive to communication(s) filed on *Feb 26, 2002*

2a) [X] This action is **FINAL.** 2b) [ ] This action is non-final.

3) [ ] Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) [X] Claim(s) *1-18* is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) [ ] Claim(s) _____ is/are allowed.

6) [X] Claim(s) *1-18* is/are rejected.

7) [ ] Claim(s) _____ is/are objected to.

8) [ ] Claims _____ are subject to restriction and/or election requirem

Application Papers

9) [ ] The specification is objected to by the Examiner.

10) [ ] The drawing(s) filed on _____ is/are a) [ ] accepted or b) [ ] objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) [X] The proposed drawing correction filed on *Feb 26, 2002* is: a) [X] approved b) [ ] disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) [ ] The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) [ ] Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) [ ] All b) [ ] Some* c) [ ] None of:

1. [ ] Certified copies of the priority documents have been received.
2. [ ] Certified copies of the priority documents have been received in Application No. _____.
3. [ ] Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) [ ] Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) [ ] The translation of the foreign language provisional application has been received.

15) [ ] Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) [X] Notice of References Cited (PTO-892)
2) [ ] Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) [ ] Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) [ ] Interview Summary (PTO-413) Paper No(s). _____
5) [ ] Notice of Informal Patent Application (PTO-152)
6) [ ] Other:

DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on February 26, 2002. **Claims 1-18** are now pending in the present application. **This action is made FINAL.**

Drawings

2. The proposed drawing correction filed on February 26, 2002 have been approved by the Examiner. A proper drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 1, 8, 15, and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky (U.S. Patent # 5,255,307)** in view of **Bartle et al. (U.S. Patent # 6,018,655)**, as applied in the first Office Action.

Consider **claims 1, 8, 15, and 17**, Mizikovsky clearly shows and discloses a mobile station 18 (wireless terminal) and a method for alerting a mobile station (wireless terminal) user of a handoff of a cell from a first communication service station 12 to a second communication service station 25 (figure 2), said mobile station 18 (wireless terminal) and method comprising:

a transceiver 32 (receiver) that receives a handoff indicating message (figure 8, column 9 lines 28-31 and 45-57, and claim 7);

a memory 44 containing System Identification Data (SID_S) (acceptable identifier) (figure 8 and column 13 lines 50-54); and

a microprocessor 60 (processor) that determines if a received System Identification Data (SID_R) (received identifier) of the second communication service station 25 match the stored System Identification Data (SID_S) (acceptable identifier) (figure 8, column 13 lines 50-54, and column 14 lines 26-32) and activates a visual status indicator 48 during the call (abstract and column 3 lines 41-45) if the received System Identification Data (SID_R) (received identifier) does not match the stored System Identification Data (SID_S) (acceptable identifier) (abstract, column 3 line 58 - column 4 line 8, and column 13 lines 54-59).

Although Mizikovsky does not specifically discloses that the memory 44 contains a collection of acceptable identifiers (i.e., a plurality of SID's), it would have been clearly obvious to a person of ordinary skill in the art at the time the invention was made to include a plurality of SID's in the memory 44 of Mizikovsky, since Mizikovsky clearly disclose that the status indicator 48 of the mobile station (wireless terminal) is selectively controlled as the mobile station moves through service cells that are serviced by **different providers** (e.g., having different SID's) (column 3 lines 41-45).

However, Mizikovsky only disclose that the status indicator 48 outputs a visual indication to the user of a status change, and therefore, fails to disclose that an audible or a vibrating indication or alert to the user is outputted by the status indicator 48.

Bartle et al. clearly show and disclose a cellular telephone 10 (wireless terminal) and a

method for indicating to a user of an imminent inter-system handoff in which the cellular telephone 10 (wireless terminal) provides a visual, vibrating, or audible alert to the user upon determining that an inter-system handoff is imminent (figure 1 and column 9 lines 38-58).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further modify the teachings of Mizikovsky with the teachings of Bartle et al. to provide additional alerting means, such as audible or vibrating alerts, when a inter-system handoff is imminent in order to enable the user to be aware of the mobile telephone status (i.e., roaming) without having the need to constantly look at a display of the mobile telephone to know the current status of the telephone, specially when the user is currently on a telephone call.

5. **Claims 2-7, 9-14, 16, and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky (U.S. Patent # 5,255,307)** in view of **Bartle et al. (U.S. Patent # 6,018,655)**, **as applied to claims 1, 8, 15, and 17**, and further in view of **Son et al. (U.S. Patent # 6,201,957 B1)**, as applied in the first Office Action.

Consider **claims 2, 6, 7, 9, 13, 14, 16, and 18**, and **as applied to claims 1, 8, 15, and 17 above**, Mizikovsky as modified by Bartle et al. clearly discloses the claimed invention except that the call is automatically terminated, by means of the processor, after producing the vibrating or audible alert if a call continuation indication is not received.

Son et al. clearly show and disclose a system and method for implementing flexible calling plans in which when a subscriber moves from a home region to a roaming region during a

call, the subscriber is alerted and provide with four options to terminate the call, wherein among said options, an option of terminating the call is included (figure 4, column 5 lines 58-64, and column 6 line 44 - column 7 line 9).

Although Son et al. disclose that the call is dropped when the handset is out of range of the home of the base station, it would have been obvious to a person of ordinary skill in the art at the time the invention to slightly modify the teachings of Son et al. to automatically terminate the call if the subscriber has not provided a call continuation indication (i.e., selection of an option) after, for example, a predetermined time or a user programmed time.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further modify the combined teachings of Mizikovsky and Bartle et al. with the modified teachings of Son et al. in order to allow automatic termination of a call when the subscriber has failed to provided a call continuation indication, thereby protecting a subscriber of higher call charges when roaming to a visiting network.

Consider **claims 3-5 and 10-12**, and **as applied to claims 2 and 9 above**, although the combined teachings of Mizikovsky, Bartle et al., and Son et al. does not specifically disclose that the call continuation indication can be an utterance or an activation of key, the Examiner takes Official Notice that is notoriously well know in the art of mobile telephones to provide indications or commands to a mobile telephone via speech (i.e., an utterance) or manually (i.e.,activation of a key) using information provided in a display of the mobile telephone.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to further modify the combined teachings of Mizikovsky, Bartle et al., and Son et al. with well known teachings in the art of mobile telephones in order to provide an indication or command to the mobile telephone via speech (i.e., an utterance) or manually (i.e., activation of a key).

Response to Arguments

6. Applicant's arguments filed on February 26, 2002 have been fully considered but they are not persuasive.

In response to Applicant's argument, on page 7 of the remarks, that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the present application, the teachings of both, Mizikovsky and Bartle et al., solve the problem of notifying a user of a wireless terminal, even at the time in which the user is engaged in a telephone call (see abstract of Mizikovsky), of a change in the status (i.e., from a home network to a roaming network, inter-system handoff) of the wireless terminal.

As explained in the above rejection, Mizikovsky teaches the claimed invention except that the notification of the user is performed via an audible or vibrating alert and Bartle et al. clearly disclose that the notification of the user is performed via an audible, a visual, or a vibrating alert in order to get the user's attention to the notification of the inter-system handoff (see column 9 lines 38-58 of Bartle et al.).

It clear from the combined teachings of Mizikovsky and Bartle et al., when taken as a **whole**, that alternative means of notification, such as an audible or vibrating alert, can be used to get the user's attention to the notification even at the time when the user is engaged in a telephone call, therefore, a person of ordinary skill in the art at the time the invention was made would have clearly recognized that, by providing such alternative means of notification, the user will be notify of the change in status of the wireless terminal even if the user is engaged in a call at the time the notification is generated and, consequently, without the need to look at a display of the wireless terminal to know the current status of the wireless terminal.

In conclusion, the motivation for combining the teachings of Mizikovsky and Bartle et al. was clearly derived from the combined references themselves and not from Applicant's disclosure as argued by the Applicant.

Additionally, Applicant further argues, on page 9 first paragraph of the remarks, that "Mizikovsky specifically teaches away from using multiple identifiers at the mobile station to determine whether it has a non-roaming status with other service providers".

The Examiner respectfully disagrees with Applicant's argument because Mizikovsky

clearly disclose that the status indicator 48 of the mobile station (wireless terminal) is selectively controlled as the mobile station moves through service cells that are serviced by different providers (e.g., having different System Identification Data (SID's)) (column 3 lines 41-45), thereby clearly suggesting that a collection of acceptable identifiers can be stored and used when controlling the status indicator 48.

Furthermore, as opposed to Applicant's argument, also on page 9 first paragraph of the remarks, in Mizikovsky the mobile station can also control the status indicator in the mobile station (column 7 lines 24-51).

Applicant also request prior art evidence for the Official Notice statement made by the Examiner in the first Office Action in relation to providing indications or commands to a mobile telephone via speech (i.e., an utterance) or manually (i.e.,activation of a key) using information provided in a display of the mobile telephone.

Several references showing the above features have been made of record at the conclusion of the present Office Action in response to Applicant's request for prior art evidence.

Finally, Applicant argues, on page 10 second full paragraph of the remarks, that the Examiner has failed to provide a showing or motivation for modifying the combined teachings of Mizikovsky, Bartle et al., and Son et al. with the alleged well known feature of providing indications or commands to a mobile telephone via speech (i.e., an utterance) or manually (i.e.,activation of a key) using information provided in a display of the mobile telephone.

The Examiner respectfully disagrees with Applicant's argument because the motivation

for the above-mentioned modification was clearly stated in the first Office Action. The motivation was to allow for the provision of an indication or command to the mobile telephone via speech (i.e., an utterance) or manually (i.e., activation of a key).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Gerson et al. (U.S. Patent # 4,945,570) disclose a method for terminating a telephone call by voice command in which the telephone call is terminated by the user by means of speech utterances (see, for example, abstract);

Waldman (U.S. Patent # 5,402,481) discloses an abbreviated and enhanced dialing apparatus and methods particularly adapted to cellular or other types of telephone systems in which cellular telephones can be controlled by a combination of voice and keypad control systems (see, for example, column 23 lines 10-20);

Schroeder et al. (U.S. Patent # 5,797,098) disclose a user interface for a cellular telephone in which soft keys 9 (figure 1) are used and their respective function is indicated on the display of the cellular telephone (column 3 lines 20-34);

Holmström et al. (U.S. Patent # 6,198,939 B1) disclose a mobile telephone with a help search tool that can be controlled via voice or keystrokes commands (column 5 lines 21-29);

Son et al. (U.S. Patent # 6,212,408 B1) disclose a voice command system and method for a communication device (abstract and column 1 line 60 - column 2 line 13).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any response to this Office Action should be **faxed to** (703) 872-9314 **or mailed to**:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Hand-delivered responses should be brought to

Crystal Park II
2021 Crystal Drive
Arlington, VA 22202

Sixth Floor (Receptionist)

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, William G. Trost IV can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.

Rafael Perez-Gutierrez
R.P.G./rpg RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER

May 17, 2002

WILLIAM TROST
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